

### **Remarks**

Applicant thanks the Examiner for withdrawing the rejections under 35 U.S.C. § 102(b) over Corte and Alpert.

#### The Amendments

Claim 1 has been amended to recite a first mammal “having a heart wound.” This recitation is supported on page 3, line 30, to page 4, line 1: “Thyroid hormone levels can be decreased prior to wounding, after wounding, or concomitant with wounding.” Claim 1 also has been amended to recite “an amount of a thyroid hormone-lowering agent effective to decrease a level of a T3 or T4 thyroid hormone by at least 80% relative to the T3 or T4 thyroid hormone level in a second mammal to whom the thyroid hormone-lowering agent has not been administered.” This recitation is supported on page 4, lines 1-4: “Thyroid hormone levels (e.g., levels of T3 and/or T4) preferably are decreased by at least 10%, 25%, 50%, 60%, 70%, or 80% relative to thyroid hormone levels in a mammal which has not been treated according to the invention.” Minor amendments have been made to claims 15-17 consistent with the amendments to claim 1.

Claim 20 has been canceled. New claim 26 is supported by claim 1 as originally filed and by the portions of the specification quoted above.

These amendments were not made earlier because Applicant believed the amendments and arguments made in the previous response were sufficient to overcome the rejections and

because Applicant did not previously have a chance to address the newly cited references. The amendments do not add new matter and do not require a new search.

Unexamined Subject Matter

Claims 1, 2, and 16-23 have been examined with respect to propylthiouracil as the elected species thyroid hormone-lowering agent. If these claims are found allowable with respect to the elected species of propylthiouracil, Applicant respectfully requests that the patentability of claims 1, 16-23, 24, and 25 be considered with respect to the other species of thyroid hormone-lowering agent recited in claims 3-5. M.P.E.P. § 809.02(e).

The Rejection of Claims 1, 2, 17-20, 24, and 25 Under 35 U.S.C. § 102(b)

Claims 1, 2, 17-20, 24, and 25 stand rejected under 35 U.S.C. § 102(b) as anticipated by Chappel *et al.*, *Endocrinology* 65, 208-15, 1959 (“Chappel”). Applicant respectfully traverses the rejection.

To anticipate a claim under 35 U.S.C. § 102, each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Chappel does not disclose each element of amended independent claim 1.

Chappel is cited as teaching “methods wherein rats were treated with propylthiouracil, and then subsequently cardiac lesions were induced in the rats using isoproterenol.” Final Office Action at page 5, last paragraph. Amended independent claim 1, however, is directed to a

method of increasing healing of a heart wound in a mammal that already has a heart wound. Thus, Chappel does not anticipate the subject matter of independent claim 1 or dependent claims 2, 17-20, 24, or 25.

Chappel also does not anticipate the subject matter of newly added claim 26, which is directed to a method of increasing healing of a heart wound in a human. Chappel treated only rats.

Applicant respectfully requests withdrawal of the rejection.

The Rejection of Claims 1, 2, 16-19, 21, and 22 Under 35 U.S.C. § 102(b)

Claims 1, 2, 16-19, 21, and 22 stand rejected under 35 U.S.C. § 102(b) as anticipated by Treadwell *et al.*, *Obstetrics and Gynecology* 87, 5 pt 2, pages 838-40, May 1996 (“Treadwell”). Applicant respectfully traverses the rejection.

To anticipate a claim under 35 U.S.C. § 102, each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Treadwell does not disclose each element of amended independent claim 1.

Treadwell is cited as disclosing a method of treating a human fetus having pericardial effusion by maternal administration of propylthiouracil. Final Office Action at page 6, last paragraph. In Treadwell, the mother is treated with PTU to correct the hyperthyroidism and the direct thyroxin effects on the fetal heart. This is unrelated to treatment of a heart wound in the fetus. In addition, amended independent claim 1 recites “an amount of propylthiouracil effective

to decrease a level of a T3 or T4 thyroid hormone by at least 80% relative to the thyroid hormone level in a second human to whom the propylthiouracil has not been administered.” Table 1 of Treadwell teaches reduction of T3 and T4 levels; none of these levels are reduced by at least 80% as recited in amended claim 1. Thus, Treadwell does not anticipate the subject matter of independent claim 1 or dependent claims 2, 17-20, 24, or 25. For the same reason, Treadwell also does not anticipate the subject matter of newly added claim 26, which also recites “at least 80%.”

Applicant respectfully requests withdrawal of the rejection.

The Rejection of Claims 1, 2, 15-22, 24, and 25 Under 35 U.S.C. § 112, second paragraph

Claims 1, 2, 15-22, 24, and 25 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Applicant respectfully traverses the rejection.

The Final Office Action asserts that the recitation “low normal level” is indefinite. To advance prosecution, this recitation has been deleted from independent claim 1.

Applicant respectfully requests withdrawal of the rejection.

The Rejection of Claims 1, 2, 15-22, 24, and 25 Under 35 U.S.C. § 112, first paragraph

Claims 1, 2, 15-22, 24, and 25 stand rejected under 35 U.S.C. § 112, first paragraph, as not sufficiently described in the specification. Applicant respectfully traverses the rejection.

The Final Office Action asserts that the specification does not sufficiently describe the recitation “effective to decrease a level of a thyroid hormone in the mammal to a low normal

level or to a below normal level." To advance prosecution, this recitation has been deleted from independent claim 1.

Applicant respectfully requests withdrawal of the rejection.

Respectfully submitted,  
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